

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Graczyk et al.

Group Art Unit: 1626

Application No.: 10/509,128

Confirmation No.: 4053

Patent No.: 7,534,800

Filed: July 28, 2005

Examiner: Loewe, Sun Jae Y.

Issue Date: May 19, 2009

For: Azaindoles as Inhibitors of C-JUN N-Terminal Kinases for Treatment of
Neurodegenerative Disorders

Attorney Docket No: 102286.154US1

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF THE PATENT TERM
ADJUSTMENT UNDER 37 C.F.R. § 1.705

Dear Sir:

Applicants filed the “Application for Patent Term Adjustment and Request for Reconsideration for the Patent Term Adjustment Under 37 C.F.R. §§ 1.702-1.705” for the application referenced above on February 18, 2009. The USPTO issued a Response on April 17, 2009 which indicates that a decision is being held in abeyance until after the actual patent date. In addition, the Response advises Applicants to wait until the time of the issuance of the patent and file a request for reconsideration of the patent term.

The Issue Notification indicated that this application issued as US 7534800 on May 19, 2009 and recites a 264 day patent term adjustment. Applicants believe that the application is entitled to more than 264 days of term adjustment, and hereby request reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d) as follows.

Applicants believe the total patent term adjustment under 37 C.F.R. §§ 1.702-1.704 should be the total of:

(1) 164 days under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1), as recognized in the Notice of Allowance, for the Patent Office delay in issuing a first office action 14 months after the filing date minus any Applicants' delay; and

(2) 295 days under 37 C.F.R. §§ 1.702(b) and 1.703(b) for the Patent Office delay in issuing the patent after July 28, 2008 (three years from the filing date) until the actual issue date of the patent (May 19, 2009).

The periods (1) and (2) are believed not to overlap under 37 C.F.R. § 1.703(f). *See Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). Thus, the total adjustment based on (1) and (2) above should be 459 days.

The additional days of patent term adjustment are requested under 37 C.F.R. §§ 1.702(b) and 1.703(b) for the following reason.

37 C.F.R. 1.702(b) states:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a)

The instant application was filed under 35 U.S.C. § 111(a) on July 28, 2005 and therefore should have issued by July 28, 2008.

37 C.F.R. § 1.703 states in pertinent part:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) ... and ending *on the date a patent was issued* (emphasis added)

Therefore, the relevant period of delay in issuing the patent began on July 29, 2008 until the patent issued on May 19, 2009. Our calculations show that the application should receive an additional 295 day term adjustment, for a total of 459 days.

Applicants did not file a request for continued examination under 35 U.S.C. § 132(b) during prosecution of the instant application. The instant application was never involved in an

interference or maintained in a sealed condition under 35 U.S.C. § 181. Applicants did not file a notice of appeal to the Board of Patent Appeals and Interferences under 35 U.S.C. § 134 and 37 C.F.R. § 41.31 for the instant application. The instant application is not subject to a terminal disclaimer. According to Applicants' calculations, there should be no additional deduction from the calculated patent term adjustment based on delay by Applicants. Therefore, Applicants respectfully request that a total of 459 days be issued for the patent term adjustment.

Applicants submitted the \$200.00 fee in accordance with 37 C.F.R. 1.18(e) along with the "Application for Patent Term Adjustment and Request for Reconsideration for the Patent Term Adjustment Under 37 C.F.R. §§ 1.702-1.705" on February 18, 2009. Accordingly, no fee is believed to be due in connection with the present Request for Reconsideration for the Patent Term Adjustment. However, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 08-0219.

Respectfully submitted,



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Date: May 21, 2009

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Attachment: USPTO's Response mailed on April 17, 2009 to the "Application for Patent Term Adjustment and Request for Reconsideration for the Patent Term Adjustment Under 37 C.F.R. §§ 1.702-1.705" filed on February 18, 2009



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APR 17 2009

OFFICE OF PETITIONS

In re Application of :
GRACZYK et al. :
Application No. 10/509,128 : ON APPLICATION FOR
Filed: July 28, 2005 : PATENT TERM ADJUSTMENT
Atty Docket No. 0102286.00154US1 :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT AND REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §§ 1.702-1.705" filed February 18, 2009. Applicant requests that the determination of patent term adjustment be increased from 164 days to "the total number of days (205 days as of February 18, 2009) under 37 C.F.R. §§ 1.702(b) and 1.703(b) for the Patent Office delay in issuing the patent after July 28, 2008 (three years from the filing date) until the actual issue date of the patent (to be determined)." Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will

not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).


Applicant is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney, Christina Tartera Donnell, at (571) 272-3211.


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